In re Application of LEHEW et al.
Serial No. 09/347,753

REMARKS

The Office action has been carefully considered. The Office action rejected claims 1-6, 8-18, and 20-29 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,226,752 to Gupta et al. ("Gupta"). Further, the Office action rejected claim 7 under 35 U.S.C. § 103(a) as being unpatentable over Gupta in view of U.S. Patent No. 6,476,833 to Moshfeghi et al. ("Moshfeghi"). Applicants respectfully disagree.

By present amendment, claims 1, 16, and 25 have been amended for clarification and not in view of the prior art. Applicants submit that the claims as filed were patentable over the prior art of record, and that the amendments herein are for purposes of clarifying the claims and/or for expediting allowance of the claims and not for reasons related to patentability. Reconsideration is respectfully requested.

Applicants thank the Examiner for the interview held (by telephone) on July 16, 2004. During the interview, the Examiner and applicants' attorney discussed the claims with respect to the prior art. The essence of applicants' position is incorporated in the remarks below.

Prior to discussing reasons why applicants believe that the claims in this application are clearly allowable in view of the teachings of the cited and applied references, a brief description of the present invention is presented.

The present invention is generally directed to a system and method for establishing a special communication relationship between a generally-accessible web site (residing on a web server computer) and an application program which

accesses the web site through a hosted web browser (wherein both the application program and the browser reside on a client computer). The special communication relationship allows the web server computer to provide enhanced operating functionality to the client computer, such as providing state synchronization. Instead of navigating directly to the generally-accessible web site like other clients that are not running the application program, the client application program may intentionally instruct the browser to go to a special, hidden web site that, essentially, the particular client application program knows about and that is generally inaccessible by browsing the generally-accessible web site except for a browser being hosted by the application program. The hidden web site sets a special cookie on the client machine and redirects the client browser to the generally-accessible web site. At the web site, the server may get the client's special cookie from the client browser, and thereby knows that this client is actually running the application program, and that the browser is being hosted by it. With this knowledge, the server may treat the client differently from other clients that are not running the application program. For example, because the server knows the application program is present at the client, the server may synchronize the application program's local data with data maintained at the server.

Note that the above description is for example and informational purposes only, and should not be used to interpret the claims, which are discussed below.

Turning to the claims, amended claim 1 recites a computer-readable medium having computer-executable instructions, comprising at a browser hosted by a client application program, receiving a request from the client application

program to access a web page, the request providing information including a network location of the web page, the network location comprising a location only accessible by the browser hosted by the client application, accessing the web page at a server in response to the request from the client application program, receiving information from the web page, writing the information to a client storage, providing the server with data corresponding to the information received from the web page written into the client storage, the data indicating to the server that the browser is being hosted by the client application, receiving state information directed to the client application from the server based on the data having been provided to the server; and redirecting the browser to another web page that may be rendered for display to a user.

The Office action rejected claim 1 as being unpatentable over Gupta. More specifically, the Office action contends that Gupta teaches several recitations of claim 1, notably, receiving a request from the client application program to access a web page that may not be rendered for display to a user, the request providing information including a network location of that page. Figs. 1-4, column 11, lines 35-50, and column 14, lines 25-60. To this end, the Office action acknowledges that Gupta does not teach the concept of a web page that may not be rendered for display. However, the Office action contends that Gupta does teach that a click on an icon found on an applet accesses the application server wherein the application server may be hidden from the client but accessed though a login server. Column 11, line 44 of Gupta is referenced. The Office action concludes that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify

Gupta by specifying the logon server as the web page that may not be rendered for display to a user since the same functionality of accessing state information from a server is achieved. Applicants respectfully disagree.

To establish prima facie obviousness of a claimed invention, all of the claim recitations must be taught or suggested by the prior art; (*In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)), and "all words in a claim must be considered in judging the patentability of that claim against the prior art;" (*In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)). Further, if prior art, in any material respect, teaches away from the claimed invention, the art cannot be used to support an obviousness rejection. *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed Cir. 1997). Moreover, if a modification would render a reference unsatisfactory for its intended purpose, the suggested modification / combination is impermissible. See MPEP § 2143.01

Gupta is directed toward a system having two server computers, an application server and a login server. In order to alleviate demand placed on an application server, certain authentication processes are assigned to a separate login server. As such, any and all requests for access to the application server that originate from any client computer must first be directed to the login server for authentication. Once authenticated, the client computer may then communicate with the application server. Thus, the system of Gupta will redirect any and all request for access to the application server to the login server for authentication first.

In contrast, claim 1 recites receiving a request from the client application program to access a web page, the request providing information including a network location of the web page, the network location comprising a location only accessible by the browser hosted by the client application. That is, the location of the web page is hidden to all other browsers or other application programs except for the particular browser which is being hosted by the client application. As such, only the user of the client application, vis-à-vis the browser being hosted by the application program, is able to access the web page. This is quite different than the system taught by Gupta in which every browser is redirected to the login server for verification. Thus, if one were to accept the argument of the Office action that the login server is, in a sense, a web page that may not be rendered for display, *i.e.*, a hidden web page, it does not follow that the system of Gupta would in turn, redirect each and every access request to the "hidden" login server. Simply put, a login server to authenticate all users for access to another server computer is not the same as a web page having a network location comprising a location only accessible by a particular browser that is hosted by a specific client application.

Furthermore, as a matter of law, obviousness may not be established using hindsight obtained in view of the teachings or suggestions of the applicants. *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1551, 1553, 220 USPQ 303, 311, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). To guard against the use of such impermissible hindsight, obviousness needs to be determined by ascertaining whether the applicable prior art contains any suggestion or motivation for making the modifications in the design of the prior art article in order to produce

the claimed design. The mere possibility that a prior art teaching could be modified or combined such that its use would lead to the particular limitations recited in a claim does not make the recited limitation obvious, unless the prior art suggests the desirability of such a modification. See *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

Applicants submit that Gupta, whether considered alone or in any permissible combination with the prior art of record, does not support any such teachings or suggestions as to any such modification, let alone any teaching or suggestion as to how Gupta's system could be modified, or even why it might be desirable to do so. The only other way in which Gupta could be modified to reach applicants' claimed invention is via applicants' own teachings, which is impermissible by law.

Applicants submit that claim 1 is allowable over the prior art of record for at least these reasons.

Applicants respectfully submit that dependent claims 2-15, by similar analysis, are allowable. Each of these claims depends either directly or indirectly from claim 1 and consequently includes the recitations of independent claim 1. As discussed above, none of the prior art of record, including Gupta, whether considered alone or in any permissible combination, discloses or suggests the recitations of claim 1 and therefore these claims are also allowable over the prior art of record. In addition to the recitations of claim 1 noted above, each of these dependent claims includes additional patentable elements.

Turning to the next independent claim, amended claim 16 recites a computer-readable medium having computer-executable instructions, comprising providing a first web page, the web page having a network location generally inaccessible by a browser except for a client browser being hosted by a corresponding client application program, receiving a request from the client browser to access the first web page, communicating information from the first web page to the client browser, the information indicating that the first web page was accessed, redirecting the client browser to another web page that may be rendered for display to a user, at a server corresponding to the other web page, detecting the information indicating that the first web page was accessed, and communicating data from the server to the client application program.

The Office rejected claim 16 as being unpatentable over Gupta and contends that claim 16 does not recite any new limitation over claims 1-6 and 8-15, and were therefore rejected on similar grounds as claim 1. Applicants respectfully disagree.

As was shown above, Gupta teaches redirecting every single request for access of an application server to a login server for authentication prior to granting access to the application server. In contrast, claim 16 recites providing a first web page, the web page having a network location generally inaccessible by a browser except for a client browser being hosted by a corresponding client application program. That is, only requests that may originate from a computer hosting a browser through a particular application program are redirected to a web page wherein the location of the web page is generally inaccessible by a browser except

for a client browser being hosted by a corresponding client application program. Gupta not only fails to teach or suggest the recitations of claim 16, but even teaches away from the present invention in that each and every access request is redirected to the "hidden" login server regardless of the origin of the request and whether or not any particular application program is resident on a requesting client computer. Thus, for at least these additional reasons, applicants submit that claim 16 is allowable over the prior art of record.

Applicants respectfully submit that dependent claims 17-18 and 20-24, by similar analysis, are allowable. Each of these claims depends either directly or indirectly from claim 16 and consequently includes the recitations of independent claim 16. As discussed above, none of the prior art of record, including Gupta, whether considered alone or in any permissible combination, discloses or suggests the recitations of claim 16 and therefore these claims are also allowable over the prior art of record. In addition to the recitations of claim 16 noted above, each of these dependent claims includes additional patentable elements.

Turning to the last independent claim, amended claim 25 recites a system for enhanced communication between a server and a client, comprising a client including an application program and a browser hosted by the application program, a server connected to the client via a transmission medium, a first web page having a network location and operable to provide awareness data for writing to a storage of the client, the network location comprising a location only accessible by the browser that is hosted by the client application, another web page, the browser redirected thereto and providing the server with the awareness data provided by

the first web page, and the server detecting the data to recognize that the browser is being hosted by the application program and providing enhanced functionality to the application program based on the receipt of the awareness data.

The Office action rejected claim 25 as being unpatentable over Gupta and, again, contends that claim 25 does not recite any new limitation over claims 1-6 and 8-15, and were therefore rejected on similar grounds as claim 1. Applicants respectfully disagree.

As was shown above, Gupta teaches redirecting every single request for access of an application server to a login server for authentication prior to granting access to the application server. In contrast, claim 25 recites a first web page having a network location and operable to provide awareness data for writing to a storage of the client, the network location comprising a location only accessible by the browser that is hosted by the client application. That is, only requests that originate from a computer hosting a browser through a particular application program are redirected to a web page wherein the location of the web page is only accessible by the browser being hosted by the application program. Gupta, not only fails to teach or suggest the recitations of claim 25, but even teaches away from the present invention in that all access requests are redirected to the "hidden" login server regardless of the origin of the request and whether or not any particular application program is resident on a requesting computer. For at least the foregoing reasons, applicants submit that claim 25 is allowable over the prior art of record.

Applicants respectfully submit that dependent claims 26-29, by similar analysis, are allowable. Each of these claims depends either directly or indirectly from claim 25 and consequently includes the recitations of independent claim 25. As discussed above, none of the prior art of record, including Gupta, whether considered alone or in any permissible combination, discloses or suggests the recitations of claim 25 and therefore these claims are also allowable over the prior art of record. In addition to the recitations of claim 25 noted above, each of these dependent claims includes additional patentable elements.

For at least these additional reasons, applicants submit that all the claims are patentable over the prior art of record. Reconsideration and withdrawal of the rejections in the Office action is respectfully requested and early allowance of this application is earnestly solicited.

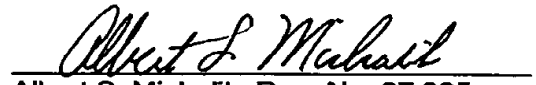
In re Application of LEHEW et al.
Serial No. 09/347,753

CONCLUSION

In view of the foregoing remarks, it is respectfully submitted that claims 1-29 are patentable over the prior art of record, and that the application is in good and proper form for allowance. A favorable action on the part of the Examiner is earnestly solicited.

If in the opinion of the Examiner a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney at (425) 836-3030.

Respectfully submitted,



Albert S. Michalik, Reg. No. 37,395
Attorney for Applicants
Law Offices of Albert S. Michalik, PLLC
704 - 228th Avenue NE, Suite 193
Sammamish, WA 98074
(425) 836-3030
(425) 836-8957 (facsimile)

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this Amendment, along with transmittal and facsimile cover sheet, are being transmitted by facsimile to the United States Patent and Trademark Office in accordance with 37 C.F.R. 1.6(d) on the date shown below:

Date: October 1, 2004

Albert S. Michalik

1880 Fourth Amendment